

## REMARKS

Applicant has studied the Office Action dated May 3, 2005, and has made amendments to the claims. Claims 1-9 and 11-16 are pending. Claims 7-9, 12, 14 and 15 have been amended. Claims 1, 4, 7 and 14 are independent claims. No new matter has been added. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

### § 112 Rejection

Claims 7-16 were rejected under 35 U.S.C. Section 112, first paragraph, as failing to comply with the written description requirement because the Examiner asserts that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner asserted that the claims recite limitations for which the Examiner cannot readily find support in the application as originally filed, noting the limitations “first mode,” “the first mode for replacing the defective segment during the formation process,” “reserving an area” and “reserved area” where “the reserved area being a part of the user area” in claims 7, 9, 12, 14 and 15.

It is respectfully noted that claim 10 has previously been canceled. It is respectfully submitted that the rejection is, therefore, moot with respect to claim 10 and it is respectfully requested that the rejection of claim 10 be withdrawn.

It is respectfully noted that claims 7, 9, 12, 14 and 15 have been amended with this paper to delete the phrases on which the Examiner based his rejection. It is, therefore, respectfully submitted that the grounds for rejection have been overcome and it is respectfully requested that the rejection of claims 7, 9, 12, 14 and 15 as well as the rejection of claims 8, 10, 11, 13, which depend from claim 7, and the rejection of claim 16, which depends from claim 14, be withdrawn.

## § 102 Rejection

Claims 1-9 and 11-16 were rejected under 35 U.S.C. Section 102(e) as being anticipated by U.S. Patent No. 6,373,800 to Takahashi ("Takahashi"). This rejection is respectfully traversed.

A proper rejection for anticipation under § 102 requires complete identity of invention. The claimed invention, including each element thereof as recited in the claims, must be disclosed or embodied, either expressly or inherently, in a single reference. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991); Standard Havens Prods., Inc. v. Gencor Indus., Inc., 953 F.2d 1360, 1369, 21 U.S.P.Q.2d 1321, 1328 (Fed. Cir. 1991).

It is respectfully noted that the Examiner asserts, at paragraph 4 of the Office action, that Takahashi discloses "performing a slipping replacement corresponding to the number of PDL entries" at col. 13, ll. 25-36. Applicant respectfully disagrees with the Examiner's interpretation of Takahashi.

It is respectfully noted that Takahashi discloses only that "a PDL ... [is] created" at col. 13, ll. 25-36. It is respectfully submitted that nowhere in Takahashi is "performing a slipping replacement" that corresponds to the "number of PDL entries" disclosed.

It is respectfully noted that the Examiner asserts, at paragraph 4 of the Office action, that Takahashi discloses "determining whether a slipping replacement error occurred in response to the number of PDL entries" and "checking a number of un-slipped PDL entries" at col. 13, ll. 38-58. Applicant respectfully disagrees with the Examiner's interpretation of Takahashi.

It is respectfully noted that Takahashi discloses only that the optical disk drive "determines that the number of spare areas is insufficient" at col. 13, ll. 38-58. It is respectfully submitted that nowhere in Takahashi is any determination "in response to the number of PDL entries" or a check of "a number of un-slipped PDL entries" disclosed.

It is respectfully noted that the Examiner asserts, at paragraph 4 of the Office action, that Takahashi discloses "adjusting the recording capacity of the recording medium based on the number of un-slipped PDL entries" and "adjusting the recording capacity of the recording medium based on the number of unreplaced defective areas" at col. 13, line 58, to col. 14, line 2 and col. 14, line 66, to col. 15, line 10. It is further respectfully noted that the Examiner asserts, at paragraph 4 of the Office action, that Takahashi discloses "reserving an area corresponding to

the number of un-slipped segments” and “reserving an area corresponding to the number of un-slipped PDL entries” at col. 13, line 58, to col. 14, line 2 and col. 14, line 66, to col. 15, line 10. Applicant respectfully disagrees with the Examiner’s interpretation of Takahashi.

It is respectfully noted that Takahashi discloses only that “a spare area addition instruction” is issued and the optical disk drive “adds spare areas” at col. 13, line 58, to col. 14, line 2 and that “spare areas can be freely expanded or contracted” at col. 14, line 66, to col. 15, line 10. It is respectfully submitted that the addition and expansion of “spare areas” is the disadvantage of the prior art that the present invention addresses by avoiding an optical disk being considered “useless” if there is “a lack of sufficient spare area”. See specification as originally filed at page 9, ll. 4-8. It is further respectfully submitted that the solution proposed by the present invention, specifically the “adjusting the recording capacity of the recording medium based on the number of un-slipped PDL entries” and “reserving an area corresponding to the number of un-slipped segments” (with “reserving an area” amended with this paper as “excluding a portion from the recording capacity”) is not disclosed anywhere in Takahashi.

To sum up the above arguments, the present invention addresses the disadvantage of the prior art in that the spare area is increased until there is insufficient spare area. The present invention, by determining if an error occurs due to insufficient spare area in comparison to the number of un-slipped defective areas, checking the number of defective areas that are un-slipped and adjusting the recording capacity of the disk accordingly, can enable a disk that would be unusable according to prior art methods to still be used.

Therefore, it is respectfully asserted that independent claims 1, 4, 7 and 14 are allowable over the cited reference. It is further respectfully asserted that claims 2 and 3, which depend from claim 1, claims 5 and 6, which depend from claim 4, claims 8, 9 and 11-13, which depend from claim 7, and claims 15 and 16, which depend from claim 14, also are allowable over the cited reference.

### CONCLUSION

In view of the above remarks, Applicant submits that the present Amendment places claims 1-9 and 11-16 of the present application in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

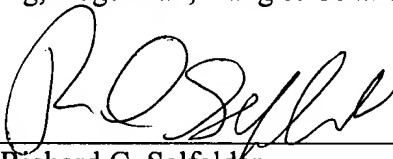
If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

Lee, Hong, Degerman, Kang & Schmadeka

Date: November 3, 2005

By: \_\_\_\_\_



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